

**REMARKS**

**I. Status of the Claims**

Claims 1-97 are pending. Claims 35, 80, 82, 89, and 94 have been amended by this response to more particularly point out and distinctly claim the subject matter Applicants regard as their invention. Support for the amendment can be found throughout the specification as originally filed. Specifically, support for expressing the loss in weight (LW) in terms of a weight percentage relative to the total weight of the composition can be found in the specification at page 6, paragraph [027].

**II. Rejection Under 35 U.S.C. § 112**

**A. Alternative Expressions**

The Examiner has rejected claims 6-16, 25-34, 42-51, 61-70, 76-78, 85, and 87 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention for the reasons stated on page 2 of the Office Action.

The Examiner asserts that alternative expressions must be drafted in proper alternative format, such as "selected from A, B, or C" or in proper Markush format, i.e., "selected from the group consisting of A, B, and C." Office Action at 2. The Examiner asserts that because the present claims are not drafted in one of those two formats, that what is meant to be encompassed by the claims is unclear. *Id.* Applicants disagree.

Applicants respectfully submit that, for example, the phrase "at least one particle chosen with a metallic glint is chosen from . . . metals and metal derivatives and . . . substrates at least partially covered with at least one layer of a metallic glint chosen

from metals and metal derivatives” is proper language and more accurately describes the claimed invention, i.e., the composition may contain one or more particles with a metallic glint with each particle independently selected from metals and metal derivatives and substrates at least partially covered with at least one layer of a metallic glint chosen from metals and metal derivatives. For example, both Applicants' claim language and the Office's proposed change cover a composition of the invention that may contain: metal particles; particles that are substrates covered with a metal derivative metallic glint; both metal derivative particles and particles that are substrates covered with a metal metallic glint, as well as all other permutations. Applicants' claim language is clearer, and provides no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. Moreover, the Office has shown no legal basis, nor does any exist, for requiring Applicants to change it.

Furthermore, the U.S. Patent and Trademark Office has provided representative examples of proper alternative claim language similar to Applicants' claim language. Specifically, Applicants direct the Office to an example of proper alternative claim language set forth in the M.P.E.P.: "wherein R1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S)." See M.P.E.P. Appendix AI (PCT), Example 20, pp. AI-71 and AI-72 of the February 2003 edition. For these reasons, Applicants request that the rejection be withdrawn.

#### **B. Calculation Method**

The Examiner has rejected claims 36 and 37 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim

the subject matter which Applicants regard as their invention for the reasons stated on page 2 of the Office Action.

The Examiner alleges that the recitation of the limitation "wherein the wear resistance is greater than [10 and 15, respectively] % by weight, relative to the total weight of the composition" is indefinite because it is unclear whether the limitation refers to a different calculation method than the wear resistance defined in claim 35. Although Applicants disagree and respectfully submit that the claims would have been clear to one skilled in the art, Applicants have amended claim 35 to recite that the percentage wear resistance is a percent by weight relative to the total weight of the composition. Accordingly, Applicants request that the rejection be withdrawn.

### **III. Rejections Under 35 U.S.C. § 102**

Under 35 U.S.C. § 102, a reference must teach each and every element recited in the claim to anticipate that claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Moreover, when a reference teaches a range that touches or overlaps the claimed range, and no specific examples fall within the claimed range, the reference must disclose the claimed subject matter with "sufficient specificity to constitute an anticipation." See M.P.E.P. § 2131.03.

M.P.E.P. § 2131.03 further states that

[i]f the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not

disclosed with "sufficient specificity" to constitute an anticipation of the claims.

See M.P.E.P. § 2131.03.

**A. U.S. Patent Application Publication No. 2003/0175225**

The Examiner has rejected claims 1-18, 21-34, 86, and 93 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent Application Publication No. 2003/0175225 to Leacock et al. ("Leacock") for the reasons stated on pages 3-4 of the Office Action. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

As an initial matter, Applicants note that the Examiner has rejected claim 86 without rejecting claim 80, from which claim 86 depends. Regarding claim 86, Leacock does not disclose a multi-compartment device or kit, as recited in claim 80, and further does not recite the translucent, semi-transparent, or transparent second composition as recited in claim 86. Therefore, Leacock fails to teach all of the elements recited in claim 86.

According to the Examiner, Leacock teaches a nail polish composition comprising aluminum platelets, silicon dioxide plates coated with a metal oxide, at least one organic solvent, at least one film-forming substance, at least one plasticizer, at least one suspending agent, and at least one adhesion promoter. See Office Action at 3. The Examiner alleges that Leacock teaches that the film-forming component "is generally provided in an amount from about 5 to 40wt% of the total weight of the composition." *Id.* at 4.

As explained above, to anticipate a claim, the reference must teach each and every element recited in the claims, and the identical invention must be shown in as complete detail as in the claims. *See Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d at 1053; *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d at 1920. In addition, when a reference does not teach specific examples within the claimed range, the reference must disclose the claimed subject matter with sufficient specificity to anticipate the claims. *See* M.P.E.P. § 2131.03. Applicants respectfully submit that Leacock does not teach the claimed ranges with sufficient specificity to anticipate the claims, and further, that Leacock does not teach all of the elements recited in the present claims.

In particular, Leacock teaches that their composition comprises a film-forming agent and a plasticizer, both of which are texturizing agents, in amounts ranging from 5.0 to 40 wt% for the film-forming agent and from 0.1 to 15.0 wt% for the plasticizer, based on the total weight of the composition. Leacock at par. [0019]-[0020]. However, Leacock is silent as to a total amount of texturing agent and in fact does not even use this term, instead focusing on the ingredients individually rather than as part of a broader category. Nowhere does Leacock teach or even remotely suggest that the total amount of such ingredients must be less than or equal to 10%. In addition, Leacock discloses nine specific examples, none of which comprise texturizing agents in an amount less than 10% of the total weight of the composition, as recited in the specific claims. *Id.* at par. [0026]-[0034]. Because of Leacock's failure to disclose a specific example falling within the claimed range, coupled with the broad range of disclosed film-

forming agent and plasticizer concentrations, Leacock does not teach the claimed invention with the sufficient specificity required by the M.P.E.P. and by U.S. case law.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

**B. U.S. Patent No. 6,296,839**

The Examiner has rejected claims 1-16, 21-34, 71-78, 88, 90-93, and 95-97 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,296,839 to Ramin et al. ("Ramin '839") for the reasons stated on pages 4-5 of the Office Action. Applicants respectfully disagree and traverse the rejection for at least the following reasons.

According to the Examiner, Ramin '839 teaches a nail varnish kit comprising a first composition containing at least one film-forming polymer and a second composition comprising, in an organic solvent, at least one film-forming polymer, at least one metal pigment, at least one organopolysiloxane, and at least one pyrogenic silica. Office Action at 4. The Examiner asserts that the film-forming polymer "preferably comprises a mixture of 0.05% to 30wt% nitrocellulose and 0.05 to 30wt% cellulose ester of the base and/or surface compositions." *Id.* at 5. The Examiner further asserts that the composition of Ramin '839 may also contain clay, plasticizing agents, and commonly used additives including thickening agents. *Id.*

As explained above, to anticipate a claim, the reference must teach each and every element recited in the claims, and the identical invention must be shown in as complete detail as in the claims. *See Verdegaal Bros. v. Union Oil Co. of California*, 2

U.S.P.Q.2d at 1053; *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d at 1920. In addition, when a reference does not teach specific examples within the claimed range, the reference must disclose the claimed subject matter with sufficient specificity to anticipate the claims. See M.P.E.P. § 2131.03. Applicants respectfully submit that Ramin '839 does not teach the claimed ranges with sufficient specificity to anticipate the claims, and further, that Ramin '839 does not teach all of the elements recited in the present claims.

Ramin '839 teaches a composition that comprising from 1% to 60% by weight of the film-forming polymer. Ramin '839 at col. 5, lines 14-19. Ramin '839 also discloses four specific examples of compositions comprising texturizing agents, including film-forming polymers. Ramin '839 at col. 7, line 43 to col. 9, line 16. None of the specific examples disclosed by Ramin '839 read upon the claimed compositions. Each of the specific examples disclosed by Ramin '839 contain more than 10% of a texturizing agent, and specifically, more than 15% of a film-forming agent. *Id.* For instance, Examples 1-4 of Ramin '839 all teach compositions comprising 15 wt% of nitrocellulose and 9 wt% of alkyd resins, both of which are film-forming polymers. *Id.* Therefore, each of the specific examples of Ramin '839 comprises at least 24 wt% film-forming or texturizing agents.

Because Ramin '839 teaches a very broad range for the concentration of the film-forming polymer--and consequently texturizing agents--and because Ramin '839 fails to disclose a single example within the claimed ranges, Ramin '839 does not disclose the claimed subject matter with sufficient specificity and therefore does not anticipate the

instant claims. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

**C. U.S. Patent No. 6,491,932**

The Examiner has rejected claims 1-35, 38-71, 88-90, and 93-95 under 35 U.S.C. §§ 102(a) and (e) as allegedly anticipated by U.S. Patent No. 6,491,932 to Ramin et al. ("Ramin '932") for the reasons stated on pages 5-6 of the Office Action. Applicants respectfully disagree and traverse the rejection for at least the following reasons.

According to the Examiner, Ramin '932 teaches a cosmetic nail varnish composition comprising glass particles coated with at least one metallic coat and at least one film-forming polymer in an amount ranging from 1 to 70% by weight of the total composition. Office Action at 5-6. The Examiner asserts that Ramin '832 teaches specific examples that read upon the instantly claimed compositions. *Id.* at 6.

As explained above, to anticipate a claim, the reference must teach each and every element recited in the claims, and the identical invention must be shown in as complete detail as in the claims. *See Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d at 1053; *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d at 1920. In addition, when a reference does not teach specific examples within the claimed range, the reference must disclose the claimed subject matter with sufficient specificity to anticipate the claims. *See* M.P.E.P. § 2131.03. Applicants respectfully submit that Ramin '932 does not teach the claimed ranges with sufficient specificity to anticipate the



claims, and further, that Ramin '932 does not teach all of the elements recited in the present claims.

Ramin '932 teaches a very broad range of concentrations for the film-forming polymers, which may be present in the composition in an amount ranging from 1% to 70% by weight relative to the total weight of the composition. *See* Ramin '932 at col. 5, lines 6-9. The composition of Ramin '932 may also contain other texturizing agents, such as plasticizers and resins. *See id.* at col. 5, line 48 to col. 6, line 60. Ramin also teaches five examples of compositions. *Id.* at col. 6, line 25 to col. 7, line 15. Contrary to the Examiner's assertion, Ramin '932 does not teach a single composition that anticipates the present claims. Each of these examples comprises texturizing agents--which include the film-forming polymers, as well as plasticizers and resins--in an amount greater than 25% of the total weight of the composition. *Id.* Examples 1 and 2 of Ramin '932 contain 10% by weight nitrocellulose and 15% by weight plasticizers and resin, and Examples 3-5 contain 11% by weight nitrocellulose and 10.1% by weight tosylamide/formaldehyde copolymer. *Id.* Furthermore, Example 5, a comparative example, is the only example disclosed by Ramin '932 that has a loss of mass greater than 5%, but Example 5 contains film-forming polymers in an amount greater than 25% by weight. *Id.* at col. 7, lines 1-38.

Therefore, Applicants respectfully submit that the extremely broad range and the failure of Ramin '932 to disclose a single specific example of a composition within the claimed range demonstrates that Ramin '932 does not disclose the claimed invention with sufficient specificity and does not anticipate the present claims. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

**IV. Rejections Under 35 U.S.C. § 103**

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. § 2143.01. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The prior art can be modified or combined to reject claims as *prima facie* obvious only as long as there is a reasonable expectation of success. M.P.E.P. § 2143.02; *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). However, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

**A. U.S. Patent Application Publication No. 2003/0175225**

The Examiner has rejected claims 19, 20, 35-85, 87-92, and 94-97 under 35 U.S.C. § 103(a) as allegedly unpatentable over Leacock for the reasons stated on

pages 6-7 of the Office Action. Applicants respectfully disagree and traverse the rejection for at least the following reasons.

**1. Wear Resistance**

The Examiner acknowledges that Leacock does not teach the wear resistance as recited in independent claims 35, 80, 89, and 94. Office Action at 6. Nevertheless, the Examiner asserts that one of ordinary skill in the art "would have been motivated to utilize routine experimentation to determine the optimum content of the components taught by Leacock et al to provide the desired wear resistance for a particular end use." *Id.* Applicants disagree.

The Examiner has failed to establish a *prima facie* case of obviousness because the Examiner has provided no evidence of a teaching or suggestion in the prior art to modify the composition of Leacock to obtain a desired wear resistance. Leacock is silent with respect to wear resistance. Moreover, it is apparent from reading the cited art that decreasing the amount of texturizing agents in such a composition would worsen the wear resistance of the composition, which is an undesired effect for nail varnishes. Without a specific teaching to the contrary, one skilled in the art would not have been motivated to alter the composition of Ramin '839 in a manner that negatively affects the nail varnish. Furthermore, the prior art does not provide any teaching or suggestion to one skilled in the art how the contents of the composition would need to be modified to achieve the desired wear resistance, let alone what comprises an "optimum content." The Examiner has provided no evidence to support this assertion.

For at least the foregoing reasons, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness, and therefore respectfully request the reconsideration and withdrawal of the rejection.

## **2. Shape Factor**

The Examiner acknowledges that Leacock fails to teach the claimed shape factor. Office Action at 7. The Examiner asserts that "platelets utilized in the art typically have a shape factor within the instantly claimed range and it would have been obvious to one having ordinary skill in the art to select a particular shape factor based on the desired aesthetic properties of the final coating." *Id.* Applicants respectfully disagree and traverse the rejection for at least the following reasons.

As explained above, obviousness can only be established where there is some teaching, suggestion, or motivation to do so. *See* M.P.E.P. § 2143.01. The Examiner has not provided any evidence of a teaching or suggestion to modify the platelets of Leacock to use the claimed shape factor. The Examiner has provided no support for the alleged "desired aesthetic properties of the final coating," or why one skilled in the art would even be motivated to modify the platelets disclosed by Leacock. The fact that such a modification is within the capabilities of one skilled in the art is not sufficient by itself to create a *prima facie* case of obviousness. *See* M.P.E.P. § 2143.01.

Therefore, Applicants respectfully request the reconsideration and withdrawal of the rejection.

## **3. Coated Silicon Dioxide Particles**

Independent claims 71 and 95 recite a proviso that "the composition does not contain silicon dioxide particles coated with a metal or a metal oxide." (Emphasis

added). The Examiner, however, asserts that one of ordinary skill in the art "would have been motivated to include or delete these coated silicone oxide particles based on the desired coloring and aesthetic properties of the final coating." Office Action at 7.

Applicants disagree.

As explained above, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (emphasis added). Leacock clearly teaches that the coated silicone dioxide particles are necessary to the invention. Leacock teaches that "[t]he present invention relates . . . to nail enamel compositions containing aluminum platelets, and silicon dioxide platelets which are coated with metal oxide." Leacock at par. [0002]. In fact, it is the silicone dioxide platelets coated with a metal oxide in combination with the aluminum which "provide a unique color change effect on a metallic or mirror-like background." *Id.* at par. [0025]. Thus, a modification as suggested by the Examiner would render the invention of Leacock unsatisfactory for its intended use.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

#### **4. Multi-compartment Kit**

The Examiner acknowledges that Leacock does not teach a composition with a second composition comprising a film-forming polymer, as recited in independent claims 72, 80, 91, 92, and 96. Office Action at 7. Nevertheless, the Examiner asserts that "it is well established in the art that nail color compositions as taught by Leacock et al, are

commonly provided commercially with a second composition comprising a film-forming polymer as instantly claimed to serve as a base coat or top clear coat in making up nails and would have been obvious to one skilled in the art at the time of the invention." *Id.* Applicants disagree.

To establish a *prima facie* case of obviousness, the prior art must teach or suggest all of the claim limitations. See M.P.E.P. § 2143.03. Leacock clearly does not teach a multi-compartment kit comprising the two compositions recited in the present claims. Furthermore, the Examiner has not provided any evidence for the bald assertion that such a multi-compartment kit is "well established in the art." Thus, the prior art does not teach or suggest all of the limitations recited in the present claims.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

**B. U.S. Patent No. 6,296,839**

The Examiner has rejected claims 17-20, 35-70, 80-87, 89, and 94 under 35 U.S.C. § 103(a) as allegedly unpatentable over Ramin '839 for the reasons stated on pages 7-8 of the Office Action. Applicants respectfully disagree and traverse the rejection for at least the following reasons.

**1. Wear Resistance**

As explained above, to establish a *prima facie* case of obviousness, the prior art must teach all of the claim limitations. See M.P.E.P. § 2143.03.

Independent claims 35, 80, 89, and 94 each recite that the composition is "capable of forming a film for which the wear resistance, expressed as loss in weight,

measured according to Standard AFNOR NF T30-015, is greater than 5% by weight relative to the total weight of the composition."

Ramin '839 is silent with respect to wear resistance. Ramin '839 does not disclose a wear resistance and does not teach or suggest a desired wear resistance. Moreover, as noted above, decreasing the amount of texturizing agents in the composition would worsen the wear resistance of the composition, an undesirable effect for nail varnishes. Without a specific teaching to the contrary, one skilled in the art would not have been motivated to alter the composition of Ramin '839 in a manner that negatively affects the nail varnish. Therefore, independent claims 35, 80, 89, and 94, and the claims dependent therefrom, would not have been obvious to one skilled in the art at the time the invention was made because Ramin '839 does not teach or suggest each and every claim element.

## **2. Particle Shape**

The Examiner acknowledges that Ramin '839 fails to teach the claimed particle shape and shape factor. Office Action at 7. Regardless of the lack of teaching, the Examiner asserts that "flat or platelet metal pigments are conventional in the art and would have been obvious to one skilled in the art at the time of the invention, wherein one could determine the optimum shape factor to provide the desired aesthetic properties for a partulaqr [sic] end use." *Id.* Applicants respectfully disagree and traverse the rejection for at least the following reasons.

As explained above, obviousness can only be established where there is some teaching, suggestion, or motivation to do so. See M.P.E.P. § 2143.01. The Examiner has not provided any evidence of a teaching or suggestion to modify the particles of

Ramin '839 to use flat or platelet metal particles or to use the claimed shape factor. Furthermore, the Examiner has not provided any evidence that shows that flat or platelet metal pigments are conventional in the art. Additionally, the Examiner has failed to provide evidence to show what an "optimum shape factor" comprises, and further how one skilled in the art would go about determining an optimum shape factor. Ramin '839 does not teach or suggest modification of the particle shape to achieve a specific end use. The fact that such a modification is within the capabilities of one skilled in the art is not sufficient by itself to create a *prima facie* case of obviousness. See M.P.E.P. § 2143.01.

Therefore, Applicants respectfully request the reconsideration and withdrawal of the rejection.

### **3. Composition Ranges**

The Examiner acknowledges that Ramin '839 does not specifically limit the compositions to the claimed ranges. Office Action at 8. Nevertheless, the Examiner asserts that "one having ordinary skill in the art at the time would have been motivated to utilize routine experimentation to determine the optimum composition for each coating layer to provide the desired aesthetic and wear resistance properties for the finished colored nails for a particular end." *Id.* at 8. Applicants disagree.

Applicants first note that the Examiner has failed to follow Office policy by ignoring the *Graham* factors. See M.P.E.P. § 2141. The Examiner has not determined the scope and content of the prior art and has failed to identify the differences between the prior art and the claims in issue. The present claims recite several different ranges.



The Examiner, however, has not identified which ranges differ from the prior art.

Therefore, it is unclear what the Examiner asserts to be obvious over Ramin '839.

Without a teaching or suggestion to modify the prior art, one skilled in the art would not have been motivated to modify the composition ranges disclosed in Ramin et al. as asserted by the Examiner. The fact that such a modification is within the capabilities of one skilled in the art is not sufficient by itself to create a *prima facie* case of obviousness. See M.P.E.P. § 2143.01. To establish a *prima facie* case of obviousness, three criteria must be met: there must be some suggestion or motivation to modify the reference teaching; there must be a reasonable expectation of success; and the reference must teach or suggest all the claim limitations. M.P.E.P. § 2143.

The Examiner has admitted that Ramin '839 does not teach all of the claim elements. Office Action at 7. However, without providing any evidence, the Examiner asserts that one skilled in the art would have been motivated to utilize routine experimentation to determine the optimum composition for each coating layer to provide the desired aesthetic and wear resistance properties. *Id.* at 8. The Examiner has not pointed to any teaching or suggestion in the prior art to modify the teaching of Ramin '839 in the manner asserted. One skilled in the art would not have been motivated to modify the composition of Ramin '839 without such guidance. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

**C. U.S. Patent No. 6,491,932**

The Examiner has rejected claims 36, 37, 72-87, 91, 92, 96, and 97 under 35 U.S.C. § 103(a) as allegedly unpatentable over Ramin '932 for the reasons stated on page 8 of the Office Action. Applicants respectfully disagree and traverse the rejection for at least the following reasons.

**1. Wear Resistance**

The Examiner acknowledges that Ramin '932 does not teach the wear resistance as recited in claims 36 and 37. Office Action at 8. Nevertheless, the Examiner asserts that "it is well established in the art that the components of the nail varnish composition as taught by Ramin et al '932 may be optimized utilizing routine experimentation to provide the desired wear resistance for a particular end use." *Id.* Applicants disagree.

As explained above, it is noted that Ramin '932 does not teach a single composition having all of the elements recited in the present claims. The Examiner asserts that Ramin teaches an example having a wear resistance greater than 5 wt%. See Office Action at 8. While Example 5 of Ramin '932 does have a wear resistance greater than 5 wt%, Example 5 also contains at least 21.2% by weight of a film-forming polymer, which is outside the ranges recited in the present claims. See Ramin '932 at col. 7, lines 1-38. In addition, Examples 3 and 4 of Ramin '932 have wear resistances less than 5% by weight. *Id.*

To establish a *prima facie* case of obviousness, there must be some teaching or suggestion in the prior art to modify the reference. M.P.E.P. § 2143. The M.P.E.P. further states that there must be some form of evidence in the record to support an assertion of common knowledge. See M.P.E.P. § 2144.03 (citing *In re Lee*, 277 F.3d

1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002). The Federal Circuit has held that general conclusions concerning what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection. *In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001).

The Examiner has provided absolutely no evidence to support the assertion that it is well established to optimize nail varnish compositions to provide a desired wear resistance. Furthermore, the prior art neither teaches nor suggests the claimed wear resistance. As discussed above, when the amount of texturizing agent is lowered, the wear resistance suffers. In other words, the more texturizing agent is in the composition, the higher the wear resistance, whereas the lower the amount of texturizing agent in the compositions, the lower the wear resistance. The relatively low amount of texturizing agent in the presently claimed invention leads to a low viscosity, which "can be favorable to the physical arrangements of [particles with a metallic glint] at the time of their application to the make-up support and, for example, favors the achievement of a homogeneous and continuous distribution of the particles, resulting in an improved mirror effect." See as-filed specification at paragraph [023]. However, this result is unexpected and could not have been reasonably foreseen by one of ordinary skill in the art. Instead, because higher texturizing agent amounts would have been understood to lead to improved wear resistance, one skilled in the art would not have been motivated to reduce the amount of texturizing agents in the cited reference because doing so would be known to provide a disadvantageous result. Consequently,

one skilled in the art would not have been motivated to modify the composition of Ramin '932 as asserted by the Examiner.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

## **2. Multi-Compartment Kit**

The Examiner acknowledges that Ramin '932 does not teach a multi-compartment kit comprising a second composition as recited in independent claims 72, 80, 91, 92, and 96. Office Action at 8. Nevertheless, the Examiner asserts that it would have been obvious to one skilled in the art to provide the second composition comprising a film-forming polymer as claimed because "it is well established in the art that nail color compositions as taught by Ramin et al '932, are commonly provided commercially with a second composition comprising a film-forming polymer as instantly claimed to serve as a base coat or top clear coat in making up nails." *Id.* Applicants disagree.

As explained above, it is the Examiner's burden to provide evidence to support an assertion that something is "well-established" in the art. Furthermore, the prior art must provide a teaching or suggestion to modify the reference as asserted by the Examiner. The Examiner has failed to meet the burden required to establish a *prima facie* case of obviousness because the prior art does not provide any teaching or suggestion to use a multi-compartment kit containing, *inter alia*, a second compartment comprising a second composition comprising at least one film-forming agent in an amount of at least 10% by weight relative to the weight of the second composition. Furthermore, there is no evidence that such a multi-compartment kit is "well-

established" in the art as alleged by the Examiner. Because Ramin '932 does not teach or suggest the multi-compartment kit comprising the second composition as claimed, one skilled in the art would not have been motivated to modify the composition of Ramin '932 as asserted by the Examiner.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

**V. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 13, 2006

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